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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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EXAMINER

SANDALS, WILLIAM O

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| ART UNIT | PAPER NUMBER |
|----------|--------------|

1636

DATE MAILED: 07/30/2002

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Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.
09/936,665

Applicant(s)
Katz et al.

Examiner
William Sandals

Art Unit
1636



-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on Sep 10, 2001
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-7 is/are pending in the application.
- 4a) Of the above, claim(s) 5-7 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-4 is/are rejected.
- 7) ☒ Claim(s) 5-7 is/are objected to.
- 8) ☐ Claims _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
*See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s). 4 6) ☐ Other:

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DETAILED ACTION

Claim Objections

1. Claims 5-7 are objected to under 37 CFR 1.75(c) as being in improper form because a multiple dependent claim cannot depend from another multiple dependent claim. See MPEP § 608.01(n). Accordingly, the claims have not been further treated on the merits.

Claim Rejections - 35 USC § 112

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claims 1-4 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 1 recites the term "substantially free of mature adipocytes". "Substantially free of mature adipocytes" is not defined in the specification or claims. Without proper guidance as to the meaning of the term, one of ordinary skill in the art would not know the metes and bounds of the claim.

Claim Rejections - 35 USC § 101

4. 35 U.S.C. 101 reads as follows:

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Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

5. Claims 1-4 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. The claimed lipo-derived stem cells read on a product of nature, since the claimed lipo-derived stem cells may be found in a tissue which is substantially free of mature adipocytes.

Claim Rejections - 35 USC § 102

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in-

(1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effect under this subsection of a national application published under section 122(b) only if the international application designating the United States was published under Article 21(2)(a) of such treaty in the English language; or

(2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that a patent shall not be deemed filed in the United States for the purposes of this subsection based on the filing of an international application filed under the treaty defined in section 351(a).

7. Claim 1 is rejected under 35 U.S.C. 102(b) as being anticipated by each of US 5,486,359 (of record), US 5,728,739 (of record), Ailhaud et al. (1983) and Vassaux et al. (of record).

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Each of US 5,486,359 (see especially column 5 and the claims), US 5,728,739 see especially column 8), Ailhaud et al. (1983) (see especially the summary and the figures) and Vassaux et al. (see especially the discussion) teaches a mammalian lipo-derived stem cell substantially free of mature adipocytes.

8. Claims 1-3 are rejected under 35 U.S.C. 102(b) as being anticipated by each of Ailhaud et al. (1985), Marko et al. (of record) and Soda et al.

Each of Ailhaud et al. (1985) (see especially the abstract and figures), Marko et al. (of record) (see especially the abstract) and Soda et al. (see the entire article) teaches a mammalian lipo-derived stem cell substantially free of mature adipocytes which may be cultured in DMEM + about 10% fetal bovine serum for at least 15 passages without differentiating, and which has two or more developmental phenotypes.

9. Claims 1-4 are rejected under 35 U.S.C. 102(b) as being anticipated by WO 98/04682 (of record).

WO 98/04682 teaches (see especially pages 3-4, example 1 and the claims) a mammalian lipo-derived stem cell substantially free of mature adipocytes which may be cultured in DMEM + about 10% fetal bovine serum for at least 15 passages without differentiating, and which has two or more developmental phenotypes which may be human.

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10. Claim 1 is rejected under 35 U.S.C. 102(e) as being anticipated by each of US 5,854,292 and US 5,827,897 (of record).

Each of US 5,854,292 (see especially columns 1, 3, 4 and 8) and US 5,827,897 (of record) (see especially column 8) teaches a mammalian lipo-derived stem cell substantially free of mature adipocytes.

11. Claims 1-4 are rejected under 35 U.S.C. 102(e) as being anticipated by US 5,827,740 (of record).

US 5,827,740 teaches (see especially columns 2, 3, 6, 7, 9 and the claims) a mammalian lipo-derived stem cell substantially free of mature adipocytes which may be cultured in DMEM + about 10% fetal bovine serum for at least 15 passages without differentiating, and which has two or more developmental phenotypes which may be human.

Conclusion

12. Certain papers related to this application are *welcomed* to be submitted to Art Unit 1636 by facsimile transmission. The FAX numbers are (703) 308-4242 and 305-3014. The faxing of such papers must conform with the notices published in the Official Gazette, 1156 OG 61 (November 16, 1993) and 1157 OG 94 (December 28, 1993) (see 37 CFR 1.6(d)). NOTE: If applicant *does* submit a paper by FAX, the original copy should be retained by the applicant or applicant's representative, and the FAX receipt from your FAX machine is proof of delivery. NO

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DUPLICATE COPIES SHOULD BE SUBMITTED, so as to avoid the processing of duplicate papers in the Office.

Any inquiry concerning this communication or earlier communications should be directed to Dr. William Sandals whose telephone number is (703) 305-1982. The examiner normally can be reached Monday through Thursday from 8:30 AM to 7:00 PM, EST. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Remy Yucel can be reached at (703) 305-1998.

Any inquiry of a general nature or relating to the status of this application should be directed to the Zeta Adams, whose telephone number is (703) 305-3291.

William Sandals, Ph.D.

Examiner

July 24, 2002


TERRY MCKELVEY
PRIMARY EXAMINER